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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,953	10/04/2001	John Moetteli	777-a	2655

7590

12/15/2005

John Moetteli  
Case Postale 486  
Geneva 12, CH-1211  
SWITZERLAND



EXAMINER

HALIM, SAHERA

ART UNIT PAPER NUMBER

2157

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/970,953

**Applicant(s)**

MOETTELI, JOHN

**Examiner**

Sahera Halim

**Art Unit**

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 18 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is in response to an Amendment filed on November 18, 2005.
2. Claims 1-4 have been amended.
3. Claims 1-4 are pending.

### ***Claim Objections***

4. Claims 2-4 are objected to because of the following informalities: Claims 2-4 are labeled incorrect. Claims 2-4 were added to the claims after the first Office Action. Therefore, they should have been labeled (currently amended).

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention of claims 3-4 is directed to non-statutory subject matter. Claims 3 and 4 are claiming a program, which is not tangible. The claims are not limited to statutory subject matter and is therefore non-statutory.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. The limitation of "persistent" and "substantially" renders the claim indefinite because based on the definition give by Merriam Webster's Collegiate Dictionary, Tenth Edition, the "persistent" means existing for a long or longer than usual time or continuously and "substantially" means to large degree. This limitation indefinite because how much time is a longer than usual or to what extent is a larger degree.

8. Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. The claim language "persistent" and "substantially" is omnibus and makes claim 1 an omnibus type claim.

9. Claims 3-4 recites the limitation "with the method of claim 1" and "with the method of claim 2" in the claims. There is insufficient antecedent basis for these limitations in the claim. Claims 3- 4 are independent claims written in a dependent form, it is suggested that either the limitations of claims 1 and 2 should be added to claims 2 and 3 where it refers to claims 1 and 2 in the claims 3 and 4 or claims 3 and 4 be written in independent form.

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 6,285,985 to Horstmann (hereinafter Horstmann).

12. Reference to claim 1, Horstmann teaches a banner management wherein the method causes the display of information in a banner window of a browser user interface on terminals in a network of terminals, wherein the information displayed on the browser user interface is persistent, being substantially visible during browsing, the method comprising the steps of (abstract): (1) initialising a command file with inputs from a system administrator of the network (col. 4, line 27 – 46 and Fig. 4; Horsmann teaches the software developer inputting information though a prompt window), including providing banner window customization means by which information displayed in a banner window on each browser interface is customizable by the system administrator (See Fig. 4 and Fig. 6 and col. 3, line 49 – 61, col. 4, line 27 – 46; Horsmann teaches customizing information displayed in banner window of Fig. 6 through selecting user profile options) (2); and executing the command file, thus displaying banners as ordered by the command file (col. 2, line 58 – col. 3, line 24).

13. Regarding claim 2 Horsmann teaches the banner management method of claim 1, wherein the information is a banner (see Fig. 6, ad screen).

14. Claims 3 and 4 have similar limitations as to claims 1 and 2, therefore they are rejected under the same rational.

#### **Acknowledgments**

15. The 112 Rejection made regarding claims 1-4 in the Final Rejections in Examiner's points 5-6 has been withdrawn due the Applicant's amendment.

16. The 112 Rejection made regarding claim 1 in the Final Rejections points 7-8 has not been withdrawn. The examiner has a duty and responsibility to the public and to the applicant to interpret the claims broadly as reasonably possible during prosecution (See *In re Prater*, 56 CCPA 1381, 415F.2d 1393). Since the definitions given by the applicant in the REMARKS for the words "persistent" and "substantially" can not be read into the claims, the applicant is requested to either include the definitions into the claims or amend the claims in such way to remove the words "persistent" and "substantially" from the claim. The applicant argues that the GUI may not always be visible. For a claim to be definite, it must clearly say when it is visible and when it is not.

#### ***Response to Arguments***

17. Applicant's arguments filed on November 18, 2005 have been fully considered but they are not persuasive.

18. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., integrating the banner window into the browser of GUI, providing a banner window of the browser interface, the browser interface includes an integrated banner window which displays messages to the user and the present invention describes a company (or project)-controlled system) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sahera Halim whose telephone number is (571) 272-4003. The examiner can normally be reached on M-F from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sahera Halim  
Patent Examiner  
AU : 2157

December 7, 2005

*Dalewca*  
*12/11/05*



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